

REMARKS

Claims 1-30 are pending in this application. By this amendment, claims 1, 9, 24, 26, 28, and 30 are hereby amended. Claims 25, 27, and 29 are canceled without prejudice or disclaimer. These claims have not been amended for reasons related to patentability, but are amended to expedite the allowance of this case. No new matter has been added by these amendments. Applicants respectfully request reconsideration of the present claims in view of the foregoing amendments and the following remarks.

Claim Rejections

Claim Rejections Under 35 U.S.C. §112, 2nd paragraph

Claims 1, 13, and 17-19 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter claimed as the invention. This rejection is respectfully traversed. The Office Action alleges that “As state an entered word is automatically stored in a list, then it is compared to the list to see if it exists in the list. At no point is it possible for the word not to exist in the list since the word was automatically added to the list one step before, thus rendering any spell-checker/auto-completion module completely useless.”

Applicants have amended claim 1 to remove any ambiguity related thereto. As to independent claim 13 and its depending claims 17-19, Applicants believe that the claims particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Withdrawal of this rejection is respectfully requested.

Claim 13 recites a spell checker for determining whether an entered word is misspelled, comprising: a custom dictionary containing a word list; a message monitor for receiving an indication that ***a new word is available***; and an automatic word addition module operative to ***add the new word*** to the word list, in response to the message monitor receiving an indication that the new word is available; wherein the indication that the new word is available is generated in response to the entry of a displayed name in a TO field of an email note.

Claim 13 adds a new word to the word list in response to the message monitor receiving an indication that the new word is available. Claims 17-19 include all the

limitations of claim 13 and recite comparing the *entered word* to the word list and indicating whether the entered word is misspelled or correctly spelled. Applicants believe that the language is not ambiguous since, in claims 17-19, the entered word is compared to the word list. Claim 13 adds a new word to the word list in response to an indication that the new word is available. That is, the new word is not automatically added to the word list, but only after receiving an indication that the new word is available. Accordingly, claims 13, and 17-19 particularly point out and distinctly claim the subject matter which Applicants regard as the invention and the respectfully request that the rejection be withdrawn.

Claim Rejections Under 35 U.S.C. §103(a)

Claims 1-11, 13-22, and 24-28 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,896, 321 to Miller et al. (hereinafter "Miller") in view of U.S. Patent Application Publ. No. 2002/0065891 to Malik (hereinafter "Malik").

As amended, claim 1 recites a method for recognizing the correct spelling of a word, the method comprising the steps of: receiving an indication that a first word has been entered into a first field; receiving an indication that a second word has been entered into a second field, the second word related to the first word; comparing the second word to a word list; indicating that the second word is a correctly spelled word, in response to finding a match between the second word and the word list; and indicating that the second word is an incorrectly spelled word, in response to failing to find a match between the second word and the word list.

Miller does not teach or suggest a method for recognizing the correct spelling of a word as recited by amended claim 1 of the present invention. The Office Action relies on the teaching of Malik to allegedly cure the deficiencies in the teaching of Miller. However, like Miller, Malik does not teach or suggest a method for recognizing the correct spelling of a word, as recited by amended claim 1.

Since either Miller nor Malik, nor a combination of the two references, teach or suggest a method for recognizing the correct spelling of a word as recited by amended claim 1, the combined teaching of Miller and Malik cannot make obvious Applicants' claimed invention embodied in independent claim 1. Further, since claims 2-12 depend from claim 1 and recite additional claim features, the combined teaching of Miller and

Malik cannot make obvious claims 2-12. Accordingly, withdrawal of this rejection and allowance of claims 1-12 is respectfully requested.

Independent claim 13 recites a spell checker for determining whether an entered word is misspelled, comprising: a custom dictionary containing a word list; a message monitor for receiving an indication that a new word is available; and an automatic word addition module operative to add the new word to the word list, in response to the message monitor receiving an indication that the new word is available; wherein the indication that the new word is available *is generated in response* to the entry of a displayed name in a TO field of an email note.

Miller does not teach or suggest a spell checker for determining whether an entered word is misspelled as recited by claim 13 of the present invention. Miller discloses a text completion system that monitors the receipt of a string of characters into a program module; determines whether a partial data entry, which is defined as the contiguous characters received since the last delimiter character, satisfies certain search criteria; if so, obtains a prioritized list of word predictions from a word prediction system; and displays the completion suggestions in priority order in a list box on the LCD display. Miller fails to teach or suggest a spell checker for determining whether an entered word is misspelled as recited by claim 13 of the present invention.

Again, the Office Action relies on the teaching of Malik to allegedly cure the deficiencies in the teaching of Miller. However, like Miller, Malik does not teach or suggest a spell checker for determining whether an entered word is misspelled as recited in independent claim 13. To the contrary, Malik teaches a method for *detecting incorrect e-mail addresses in outgoing e-mail communications*, and for responding by prompting a user with suggested e-mail addresses. A domain name database in the e-mail communications software creates a table of domain names by automatically storing the domain names of e-mail addresses from which incoming e-mails are received. When a user creates an outgoing e-mail communication, the system checks the domain name provided by the user with those domain names stored in the table. If the user-provided domain name does not match any of the domain names in the table, or closely resembles a domain name in the table, the user is prompted to confirm the provided e-mail address.

Neither Miller nor Malik, nor does a combination of the two references, teach a spell checker for determining whether an entered word is misspelled as recited in independent claim 13 of the present application. More specifically, neither Miller nor Malik teach a spell checker for determining whether an entered word is misspelled including an automatic word addition module operative to add the new word to the word list, in response to a message monitor receiving an indication that the new word is available *generated in response* to the entry of a displayed name in a TO field of an email note.

Since neither Miller nor Malik, nor a combination of the two references, teach or suggest a spell checker for determining whether an entered word is misspelled as recited by claim 13, the combined teaching of Miller and Malik cannot make obvious Applicants' claimed invention embodied in independent claim 13. Further, since claims 14-23 depend from claim 13 and recite additional claim features, the combined teaching of Miller and Malik cannot make obvious claims 14-23. Accordingly, withdrawal of this rejection and allowance of claims 13-23 is respectfully requested.

Amended claim 24 recites an email application program for sending and receiving email notes, comprising: an email name resolving module operative to determine a displayed name in response to receiving an entered email name; a new email name reporting module operative to broadcast a new resolved name message, in response to resolving a new email name; and an email name cache for storing the displayed name, wherein the displayed name is available for extraction from the email name cache by at least one module consisting essentially of a spell checker module, auto-completion module, or a smart-tags module.

Miller does not teach or suggest an email application program for sending and receiving email notes as recited by amended claim 24 of the present invention. The teaching of Malik is again used to allegedly cure the deficiencies in the teaching of Miller. However, like Miller, Malik does not teach or suggest an email application program for sending and receiving email notes as recited in amended claim 24. Neither Miller nor Malik, nor does a combination of the two references, teach an email application program for sending and receiving email notes as recited in amended claim 24 of the present application.

Since both the teaching of Miller and the teaching of Malik fail to teach or suggest an email application program for sending and receiving email notes as recited by amended claim 24, the combined teaching of Miller and Malik cannot make obvious Applicants' claimed invention embodied in claim 24. Further, since claims 26, 28, and 30 depend from claim 24 and recite additional claim features, the combined teaching of Miller and Malik cannot make obvious claims 26 and 28. Claims 25 and 27 have been canceled and the rejection of these claims is now moot. Accordingly, withdrawal of this rejection and allowance of claims 24, 26, 28, and 30 is respectfully requested.

Claims 12, 23, and 29-30 are rejected under 35 U.S.C. §103(a) as being unpatentable over Miller in view of Malik and further in view of U.S. Patent No. 5,974,413 to Beauregard et al. (hereinafter "Beauregard"). Claim 29 has been canceled by the foregoing amendments, and thus, the rejection of claim 29 is moot. The rejections of claims 12, 23, and 30 are respectfully traversed.

As discussed above with regard to amended independent claim 1, independent claim 13, and amended independent claim 24, both the teaching of Miller and the teaching of Malik fail to teach or suggest each and every limitation of these independent claims.

The teachings of Beauregard do not compensate for the deficient teachings of Miller and Malik with respect to claims 1, 13, and 24 discussed in detail above. Claim 12 depends from amended claim 1 and includes all of the recitations specified in claim 1 as well as the additional recitations contained therein. Claim 23 depends from claim 13 and includes all of the recitations specified in claim 13 as well as the additional recitations contained therein. Claim 30 depends from claim 24 and includes all of the recitations specified in claim 24 as well as the additional recitations contained therein. Since Beauregard does not compensate for the deficiencies of Miller and Malik with regard to independent claim 1, 13, and 24, Beauregard, in combination with Miller and Malik, cannot make obvious their respective dependent claims 12, 23, and 30.

Withdrawal of these rejections is respectfully requested.

CONCLUSION

For at least these reasons, Applicants assert that the pending claims are in condition for allowance. Applicants further assert that this response addresses each and every point of the Office Action, and respectfully requests that the Examiner pass this application with the remaining claims to allowance. Should the Examiner have any questions, please contact Applicants' undersigned attorney at 404.954.5040.

Respectfully submitted,
MERCHANT & GOULD, LLC



Michael T. Lukon
Reg. No. 48,164

Merchant & Gould
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
Telephone: 404.954.5100

